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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,261	08/01/2001	John Heinen	15-EC-6101 (070191-0312)	4040
7590	05/19/2005		EXAMINER	
Marcus W. Sprow FOLEY & LARDNER Firststar Center 777 East Wisconsin Avenue Milwaukee, WI 53202-5367			THEIN, MARIA TERESA T	
			ART UNIT	PAPER NUMBER
			3627	

DATE MAILED: 05/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/920,261

Applicant(s)

HEINEN ET AL.

Examiner

Marissa Thein

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Response to Amendment***

Applicants' "Amendment and Reply under 37 CFR 1.111" filed on February 18, 2005 has been considered with the following effect.

Applicants' response by virtue of amendment to claims 22-45 has overcome the Examiner's rejection of such claim under 35 USC 101.

Claims 1, 6, 12-17, 22, 25, 33, and 41 have been amended. Claims 1-45 remain pending in this application and an action on the merits of these claims follows.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 22-32 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,141,653 to Conklin et al.**

Regarding claims 22 and 29, Conklin discloses a method for purchasing customized capital equipment product (production purchasing includes components, subassemblies or parts) in an electronic market place, comprising: viewing basic product information using electronic device (allows a buyer/participant to search and evaluate seller information; col. 14, lines 3-4); providing a customer specifications (a

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buyer proposes a negotiation of order terms, col. 20, lines 24-25; buyer's request for proposal or a request for a quote, col. 20, lines 27-30); viewing a price quotation (alerts sellers and buyers that pending offer or counteroffer has been submitted, so that they may return to the system to negotiate or resume negotiations, col. 19, lines 31-34); accepting the price quotation (a seller has accepted all the terms of an open buying agreement, col. 21, lines 7-12); and communicating the acceptance to a product provider (a seller has accepted all the terms of an open buying agreement, col. 21, lines 7-12; Figure 18).

Regarding claim 23, the recitations that "the capital equipment products include medical equipment", such recitation is given little patentable weight because it imparts no structural or functional specificity which serves to patentably distinguish the instant invention from the other "capital equipment" already disclosed by Conklin.

Regarding claims 24-28, Conklin discloses viewing a business-to-business exchange web page using a web browser (Figure 14); punching through to a product provider web page (Figure 31a); answering a series of questions regarding customer requirements (Letter or Credit; Figures 15b; 15 C-1; 15 C-2); at least a portion of the questions may be answered at the provider web page (Letter or Credit; Figures 15b; 15 C-1; 15 C-2); and viewing the price quotation takes place at the exchange web page (Figure 12; Figure 13).

Regarding claims 30-32, Conklin discloses triggering an acceptance at the product provider web page (Figure 16); sending a notification to the product provider (Figure 20); and providing automatically generating a series of questions designed to

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elicit purchaser requirements and displaying the questions to a purchaser (Letter of Credit; Figures 15b; 15 C-1; 15 C-2).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-21 and 33-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,141,653 to Conklin et al. in view of U.S. Patent No. 5,260,866 to Lisinski et al.**

Regarding claims 1 and 12, Conklin discloses a system for purchasing customized capital equipment (production purchasing includes components, subassemblies or parts) in an online marketplace environment, comprising: a business-to-business exchange web page (sponsored community addresses corporate buyers and sellers engaged in production purchasing; col. 17, lines 57-58; business to business negotiation, col. 18, lines 66-67) including basic product information for a plurality of capital equipment products (allows a buyer/participant to search and evaluate seller information; col. 14, lines 3-4); at least one link included in the exchange web page for punching through from the exchange web page to a product provider web page (each member of the community to install Webserver, application server and database server software at each sponsor site and at all or some participant sites in a community such as sponsored community; col. 18, lines 54-62 ); means for presenting a price quotation

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(alerts sellers and buyers that pending offer or counteroffer has been submitted, so that they may return to the system to negotiate or resume negotiations, col. 19, lines 31-34); and an acceptance module configured for enabling acceptance of the price quotation at the exchange web page (a seller has accepted all the terms of an open buying agreement, col. 21, lines 7-12).

However, Conklin does not explicitly disclose a module of customizing a configuration of a product based on requirements received from a customer and means for configuring a standard product to includes features based on needs of a particular customer and generating a price quotation. Conklin does disclose seller's product catalogs or inventory tracking systems which the seller can integrate to the system (col. 28, lines 23-25). Conklin discloses production purchases which are defined as purchasing of components, subassemblies or parts (col. 5, lines 59-60). Furthermore, Conklin discloses buyer's proposed orders which can be based on the catalogs and special orders (col. 19, lines 63-65), wherein the proposed orders can be a request for a quote or a request for proposal (col. 20, lines 25-31).

Lisinski, on the other hand, teaches a module of customizing configuration of a product based on requirements received from a customer and means for configuring a standard product to includes features based on needs of a particular customer and generating a price quotation (col. 4, line 62-col. 5, line 2; col. 5, lines 3-7). Lisinski teaches a system which generates multiple customer work orders for the manufacture of an end item and lower level configurable items comprising the end item (abstract). The system comprises an order entry configuration for obtaining option values that

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define specification of the items (abstract). A standard part may be a part of the end item (col. 4, line 67 – col. 5, line 2). A configured part is dependent upon the user's option for that part of other configured parts (col. 5, lines 3-5). Therefore, a work order for the construction of the configured part will also depend upon the user's options as well as other data available to the system (col. 5, lines 4-7). Furthermore, Lisinski teaches pricing rules which is used to generate custom price for the end item (col. 8, lines 34-35).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the system of Conklin, to include the module of customizing a configures of a product and a means for configuring, as taught by Lisinski, in order to generate custom work orders for the item corresponding to the options selected by the user for the configured parts (Lisinski, col. 6, lines 7-9).

Regarding claim 2 and 13, the recitations that "the capital equipment products include medical equipment", such recitation is given little patentable weight because it imparts no structural or functional specificity which serves to patentably distinguish the instant invention from the other "capital equipment" already disclosed by Conklin.

Regarding claims 3-11, 14-21, 35-40, and 42-45, Conklin discloses wherein the price quotation is generated by a product provider (seller); product configurator (col. 8, lines 26-39; Figure 31b); unique customer requirements providing a customer specifications (a buyer proposes a negotiation of order terms, col. 20, lines 24-25; buyer's request for proposal or a request for a quote, col. 20, lines 27-30); wherein the product provider web page includes means for receiving customer requirements for the

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capital equipment product (Letter of Credit; Figures 15b; 15 C-1; 15 C-2); means for communicating the price quotation acceptance to a product provider (Figure 12); wherein the means for communicating includes means for triggering a price quotation acceptance at the product provider web page (Figure 16); wherein the means for communicating includes means for sending a notification to the product provider (Figure 20); a hyperlink to the product provider web page (Figures 31a); means for automatically eliciting purchaser requirements for use in generating the price quotation (Letter of Credit; Figures 15b; 15 C-1; 15 C-2); and providing automatically generating a series of questions designed to elicit purchaser requirements and displaying the questions to a purchaser (Letter of Credit; Figures 15b; 15 C-1; 15 C-2).

Regarding claims 33-34 and 41, Conklin discloses a method for purchasing customized capital equipment product (production purchasing includes components, subassemblies or parts) in an electronic market place, comprising: displaying at an electronic device basic product information (allows a buyer/participant to search and evaluate seller information; col. 14, lines 3-4); providing at the exchange web page a link to a price quotation (each member of the community to install Webserver, applicant server and database server software at each sponsor site and at all or some participant sites in a community such as sponsored community, col. 18, lines 54-62); and accepting the price quotation (a seller has accepted all the terms of an open buying agreement, col. 21, lines 7-12); and communicating the acceptance to a product provider (a seller has accepted all the terms of an open buying agreement, col. 21, lines 7-12; Figure 18).



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However, Conklin does not explicitly disclose providing a price quotation that has been customized based on needs of a purchaser and that has been configured in accordance to requirements received from a purchaser. Conklin discloses a method for iterative bargaining and purchasing over a network which enables buyers and sellers to negotiate prices, terms, and conditions iteratively until an agreement is reached on all points (col. 13, lines 51-55). Conklin does disclose seller's product catalogs or inventory tracking systems which the seller can integrate to the system (col. 28, lines 23-25). Furthermore, Conklin discloses buyer's proposed orders which can be based on the catalogs and special orders (col. 19, lines 63-65), wherein the proposed orders can be a request for a quote or a request for proposal (col. 20, lines 25-31).

Lisinski, on the other hand, teaches the providing a price quotation that has been customized based on needs of a purchaser and that has been configured in accordance to requirements received from a purchaser (col. 4, lines 63-65; col. 5, lines 3-7; col. 5, lines 45-56; col. 8, lines 34-35; Table 18; col. 20, lines 9-19). Lisinski teaches a system which generates multiple customer work orders for the manufacture of an end item and lower level configurable items comprising the end item (abstract). The system comprises an order entry configuration for obtaining option values that define specification of the items (abstract). A configured part is dependent upon the user's option for that part of other configured parts (col. 5, lines 3-5). Therefore, a work order for the construction of the configured part will also depend upon the user's options as well as other data available to the system (col. 5, lines 4-7). Furthermore, Lisinski

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teaches pricing rules which is used to generate custom price for the end item (col. 8, lines 34-35; Table 10).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Conklin, to include a price quotation that has been customized based on needs of a purchaser and that has been configured in accordance to requirements received from a purchaser, as taught by Lisinski, in order to generate custom price for the end item (Lisinski, col. 8, lines 34-35).

### ***Response to Arguments***

Applicants' arguments with respect to claims 22-32 have been fully considered but they are not persuasive.

Applicants' arguments with respect to claims 1-21 and 33-45 have been considered but are moot in view of the new ground(s) of rejection.

Applicants remark that Conklin does not disclose a method for purchasing customized capital equipment products comprising providing customer specification for a customized capital equipment product for product provider; and viewing a price quotation, as recited in claim 22.

The Examiner notes that Conklin discloses a method for iterative bargaining and purchasing over a network which enables buyers and sellers to negotiate prices, terms, and conditions iteratively until an agreement is reached on all points (col. 13, lines 51-55). Conklin does disclose seller's product catalogs or inventory tracking systems which the seller can integrate to the system (col. 28, lines 23-25). Furthermore, Conklin discloses buyer's propose orders which can be based on the catalogs and special

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orders (col. 19, lines 63-65) and a negotiation of order terms (col. 20, lines 24-25), wherein the proposed orders can be a request for a quote or a request for proposal (col. 20, lines 25-31). Moreover, Conklin discloses the alerting of sellers and buyers that pending offer or counteroffer has been submitted, so that they may return to the system to negotiate or resume negotiations (col. 19, lines 31-34).

Such method of purchasing over a network; proposing orders based on the catalogs and special orders and a negotiation of order terms, wherein the proposed order can be a request for a quote; and the alerting of buyers and seller that offers have been submitted are considered a method for purchasing customized capital equipment products comprising providing customer specification for a customized capital equipment product for product provider; and viewing a price quotation.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa Thein whose telephone number is 571-272-6764. The examiner can normally be reached on M-F 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on 571-272-6788. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mtot  
May 15, 2005

*Michael Coff* 5/15/05  
MICHAEL COFF  
PRIMARY EXAMINER